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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,331	01/16/2001	Hughes Roderick	D-2924	5991
33197	7590	04/09/2004	EXAMINER	
STOUT, UXA, BUYAN & MULLINS LLP 4 VENTURE, SUITE 300 IRVINE, CA 92618			VO, HAI	
			ART UNIT	PAPER NUMBER
			1771	
DATE MAILED: 04/09/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/761,331	Applicant(s) RODERICK ET AL.	
	Examiner Hai Vo	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-16,18,19,21-27,29-31 and 34-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 43 and 46-53 is/are allowed.
- 6) ☒ Claim(s) 1-4,6-11,13-16,18,19,21,23-27,29,30,34,35,44 and 46-53 is/are rejected.
- 7) ☒ Claim(s) 12,22,31,36-42 and 45 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1103</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4, 7, 8, 10, 11, 13, 16, 18, 19, 21, 23-25 are rejected under 35 U.S.C.

103(a) as being unpatentable over by Meglino (US 5,899,442) in view of Godavarti et al (US 6,265,037) substantially as set forth in the 01/29/04 amendment. Applicant argues that Meglino discloses a **two layer** composite component which is augmented by wings which do not substantially completely circumscribe either the outer layer or the inner core of the two layer composite component. The arguments are not found persuasive for patentability. Meglino teaches a fence insert comprising **at least three layers** wherein at least two or three of the layers are made of different polymeric materials (column 1, lines 60-63). Figures 2 and 6 of Meglino show that the inner core substantially completely circumscribed by the outer layer. There are no reasons why Meglino does not disclose the inner layer substantially completely circumscribed by the core layer in view of the passage at column 1, lines 60-63 and figures 2 and 6. Applicant argues that Godavarti does not teach or disclose the composite component having a structure recited in the claims. There is no need for Godvarti to address composite component having a structure recited in the claims because such is already taught by Meglino. Meglino does not specifically teach polyethylene or polypropylene being a thermoplastic material.

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Godavarti, however, teaches a polyolefin wood fiber composite that comprises a combination of wood fiber with polypropylene thermoplastic material (column 6, lines 65-66). The teaching of Godavarti would give the skilled artisans the tools necessary to conclude that polypropylene is simply a thermoplastic material. Accordingly, the art rejections are thus sustained.

3. Claims 6, 9, 15, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meglino (US 5,899,442) in view of Godavarti et al (US 6,265,037) as applied to claim 1 above, further in view of Sandt (US 5,858,493) substantially as set forth in the 01/29/04 amendment. Applicant argues that since Sandt teaches the central core is a thermosetting resin, Sandt teaches clearly directly and expressly away from the present invention involving composites having core layers comprising thermoplastic materials. The examiner disagrees. It is noted that Sandt reference is relied on as a secondary reference that teaches the fence has a rectangular cross-section. In view of the teaching of the Sandt reference, the rectangular cross section is a typical and common shape of the fence in the pole art. The examiner wishes to point out that since the shape of the pole, **not** the chemistry of the central core on which the Sandt reference is relied, the Sandt does not teach away from the present invention as argued by Applicant.
4. Claims 26, 27, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meglino (US 5,899,442) in view of Godavarti et al (US 6,265,037) and as evidenced by Robbins, III (US 4,860,996). Meglino does not teaches a fencing system having a structure as recited in the claims. Robbins, III is relied as evidence

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that teaches the fencing system having a plurality of fence posts and fence rails being connected to each other (figure 1). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the fencing system having a structure disclosed in Robbins, III because such is common structure of the fencing system and Robbins provides necessary details to practice the invention of Meglino.

5. Claims 29 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meglino (US 5,899,442) in view of Godavarti et al (US 6,265,037) and as evidenced by Robbins, III (US 4,860,996) as applied to claim 26 above, further in view of Sandt (US 5,858,493) substantially as set forth in the 01/29/04 amendment. The same reasons as set forth in the paragraph no. 2 and 3 are believed to be pertinent.
6. The indicated allowability of claim 14 is withdrawn in view of the newly discovered reference(s) to Hughes (US 5,883,191). Rejections based on the newly cited reference(s) follow.
7. Claims 1-4, 7, 8, 10, 11, 13, 14, 16, 18, 19, 21, 23-25 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Meglino (US 5,899,442) in view of Hughes (US 5,883,191). Meglino teaches a fence insert comprising at least three layers wherein at least two or three of the layers are made of different polymeric materials (column 1, lines 60-63). The examiner interprets that the fence inserts comprises three layers, an inner layer, a core and an outer layer wherein at least two of three layers are made of different polymeric materials. Figures 2 and 6 of Meglino show that the inner core substantially completely circumscribed by the outer layer.

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There are no reasons why Meglino does not disclose the inner layer substantially completely circumscribed by the core layer in view of the passage at column 1, lines 60-63 and figures 2 and 6. Meglino teaches the polymeric materials being polyethylene, polypropylene (column 3, lines 1-10). The inner layer defines a hollow space extending along the entire length of the fence insert and the wall thickness of the inner layer and outer layer are shown to be constant (figure 2, column 2, line 36, and column 3, lines 30-32). The fence insert is formed by co-extrusion (column 3, lines 41-43). Meglino does not specifically teach the core layer comprising a wood filler and a polymeric material selected from the group consisting of PVC, acrylonitrile/styrene/acrylic polymeric materials and combinations. Huges, however, teaches that an article made of acrylonitrile/styrene/acrylic and wood filler is resistant to the effects of outdoor weather on a long term basis (column 3, lines 15-30). This is important to the expectation of successfully practicing the invention of Meglino, thus suggesting the modification. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the acrylonitrile/styrene/acrylic and wood filler for the polypropylene of the core motivated by the desire to provide the fence with excellent weather resistance.

Allowable Subject Matter

8. Claims 43, and 46-53 are allowed.
9. Claims 12, 22, 31, 36-42 and 45 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The inclusion of the

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core layer made of a thermoplastic polymeric foam and a wood filler renders the claims patentable over the prior art. It is known in the art that the foamed thermoplastic polymer/wood fiber profile accepts and retains the insertion of fasteners easily. There is no motivation to modify the core of the fence insert of Meglino to be a foamed thermoplastic polymer/wood fiber layer because no nails have been associated with the fence insert.

Further, the inclusion of the first polymeric material and the third polymeric material made of polyvinyl chloride and the second polymeric material is selected from the group consisting of polyvinyl chloride, acrylonitrile/styrene/acrylic and combinations thereof provides structural distinction over the prior art.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (571) 272-1485. The examiner can normally be reached on M,T,Th, F, 7:00-4:30 and on alternating Wednesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hai Vs

HV